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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,788	07/14/2003	Roland Feola	02/041 VAT	7344
23416	7590	12/19/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 12/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/618,788

Applicant(s)

FEOLA ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/19/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 1 incorporates a new Markush group in which “Ca selected from the group of dihydroxy compounds consisting of ...” followed by numerous recitations of “and” and terminated with “...and from the group of polyhydroxy compounds consisting of...”. It is unclear where the Markush group or groups are supposed to end or if only one Markush group is intended and if so whether the broad terms followed by “consisting” include members not specified after “consisting” in the claimed Markush group. This indefiniteness results from using improper Markush language. See MPEP 2173.05(h).

B. It is unclear what is meant and encompassed by “the higher homologues thereof” and “the higher oligomers of these”.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US

Publication No. 2002/0077389 A1 Dworak et al..

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Dworak et al. discloses a composition falling within the scope of that of the instant claims where the polyol of the references condensation product AB (page 1, sections [0006] through [0012]; page 2, sections [0013] through [0020], of which [0015] encompasses the use of excess OH functional polyurethane and said excess of OH functional urethane reads on component C of the instant claims as it is not removed from the compositions of Dworak, and the OH functional urethane which results when AB is made with excess OH functional resin also falls within the scope of the instantly claimed components AB and C. Note that polymers are mixtures of different molecules and some of the molecules of the reference may be deemed as being AB and some as C. See the definitions of average molecular weights and average functionalities, etc. in polymer chemistry texts. See page 3, section [0024]; page 4, sections [0027] of which the diisocyanates disclosed by the patentee encompass those of the instant claims. It does not require too much picking and choosing from the diisocyanates of the reference to arrive at those polyisocyanates of the instant claims because the instantly claimed polyisocyanates are those which are most typically employed in polyurethane coatings, as evidenced by their use in the exemplified polyurethanes of the reference and page 2, section [0018]. These polyurethanes will necessarily have terminal OH groups according to the instant claim 2. The instantly claimed component D is encompassed by page 4, section [0032]. These curatives are necessarily “water dilutable” according to the instant claim 4 as they are used in water. The instant claim 5 is encompassed by page 4, section [0027]. The instant claim 6 is encompassed by page 1, sections [0010] through [0012] and page 2, section [0015]. Page 2, section [0015] encompasses the instant claim 7. All of the mass fractions recited by the reference and the required use of curatives of the reference encompasses the instant claim 8. The method of claim 9 is done

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above. The instant claim 10 intended use is recited in the abstract and the above composition meets the limitations of the instant claim 10 as it is capable of being an automotive surfacer.

This rejection interprets the Markush group rejected in paragraph 1 above requiring only one of the entire list of components recited after “selected from...” The components of section [0027] read on those of the newly amended claim 1. There is no evidence that the ratios referenced above do not give the instantly claimed amounts of the instant claims 1 and 7. Given the breadth of the disclosed ratios, these amounts appear to be encompassed. This rejection is therefore maintained.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2002/0077389 A1 Dworak et al..

Dworak et al. discloses a composition falling within the scope of that of the instant claims where the polyol of the references condensation product AB (page 1, sections [0006] through [0012]; page 2, sections [0013] through [0020], of which [0015] encompasses the use of excess OH functional polyurethane and said excess of OH functional urethane reads on component C of the instant claims as it is not removed from the compositions of Dworak, and the OH functional urethane which results when AB is made with excess OH functional resin also falls within the scope of the instantly claimed components AB and C. Note that polymers are mixtures of different molecules and some of the molecules of the reference may be deemed as being AB and some as C. See the definitions of average molecular weights and average functionalities, etc. in polymer chemistry texts. See page 3, section [0024]; page 4, sections [0027] of which the diisocyanates disclosed by the patentee encompass those of the instant claims. It does not require too much picking and choosing from the diisocyanates of the reference to arrive at those

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polyisocyanates of the instant claims because the instantly claimed polyisocyanates are those which are most typically employed in polyurethane coatings, as evidenced by their use in the exemplified polyurethanes of the reference and page 2, section [0018]. These polyurethanes will necessarily have terminal OH groups according to the instant claim 2. The instantly claimed component D is encompassed by page 4, section [0032]. These curatives are necessarily "water dilutable" according to the instant claim 4 as they are used in water. The instant claim 5 is encompassed by page 4, section [0027]. The instant claim 6 is encompassed by page 1, sections [0010] through [0012] and page 2, section [0015]. Page 2, section [0015] encompasses the instant claim 7. All of the mass fractions recited by the reference and the required use of curatives of the reference encompasses the instant claim 8. The method of claim 9 is done above. The instant claim 10 intended use is recited in the abstract and the above composition meets the limitations of the instant claim 10 as it is capable of being an automotive surfacer.

This rejection interprets the Markush group rejected in paragraph 1 above requiring only one of the entire list of components recited after "selected from..." The components of section [0027] read on those of the newly amended claim 1. There is no evidence that the ratios referenced above do not give the instantly claimed amounts of the instant claims 1 and 7. Given the breadth of the disclosed ratios, these amounts appear to be encompassed. This rejection is therefore maintained.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above discussed combinations of ingredients and amounts thereof because they are encompassed by the reference and would have been expected to give a coating having the properties described therein.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

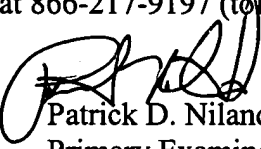
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland  
Primary Examiner  
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